

REMARKS

Summary of the Office Action

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Fabrig* (USPN 4,559,981).

Summary of the Response to the Office Action

Applicant has amended claims 1, 4, and 6. New claim 20 has been added to further define the invention. Claims 10, 12-13, and 16-17 have been cancelled without prejudice or disclaimer. Claims 4-9, 11, 14-15, and 18-19 have been withdrawn. Accordingly, claims 1-3 and 20 are under review with claims 1-9, 11, 14-15, and 18-20 presently pending.

The Rejection Under 35 U.S.C. § 102(b)

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Fabrig*. Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully submits that the features of newly amended independent claim 1 are not found in *Fabrig*. That is, *Fabrig* does not disclose at least “[a] bind processing method . . . the binder comprising a *continuous rectangular bar-like* spine portion and a plurality of *hinged* first and second division ring portions arranged at regular intervals along both long sides of the *continuous rectangular bar-like* spine portion, the spine portion being interposed between the first and second division ring portions,” as recited in claim 1. Emphasis added.

The amendment to claim 1 found in the preamble, does give life, meaning and vitality to the claims and limits the structure of the claimed invention such that it should be considered and given patentable weight. See M.P.E.P. § 2111.02 states:

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003)(In considering the effect of the preamble in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the claims' recitation of a patient or a human "in need" gives life and meaning to the preamble's statement of purpose.).

Thus, Applicant respectfully submits that *Fabrig* does not anticipate the invention recited in amended claim 1. On page 3, lines 11-14 of the Office Action the Examiner points out distinguishing features that are now incorporated in the preamble. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn.

New Claim 20

Applicant respectfully requests allowance of dependent claim 20, which depends from newly amended independent claim 1. The claim is allowable insofar as it recites the patentable combinations of features recited in its base claim, as well as reciting additional features that further distinguished over the applied prior art.

Accordingly, in view of the above amendments, claim 20 is allowable and pending for further consideration.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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